REMARKS

Applicant has resubmitted drawings with further identification information. There has been no change to the content of the drawings.

The claims have been amended to address the 35 U.S.C. §112 issues.

The present invention results from the discovery that by reducing the initial amount of data-entry fields displayed for a user and allowing the user to reconfigure the search engine, patent searching can be drastically easier and more efficient.

First, a user can be authenticated using the user ID input unit 41 and the user ID from the user. (Pg. 19, lns. 24 – 26) As seen in Figure 12, the search category modification unit 44 displays the search categories 203 and the field display unit 43 displays the data-entry fields 202. (Pg. 20, lns. 14 – 25). This allows a user to reconfigure the search engine to determine what data entry fields are available. When a user selects a category, the category expands to show the category list 301 and 401 as shown in Figures 14 and 15. As shown in Figure 14, Classification by Law and IPC have been selected, which results in Classification by Law and IPC being shown as data-entry fields. As shown in Figure 15, when Publication Number and Registration Number have been selected in category list 401 from Numbers in addition to Classification by Law and IPC, the Publication Number and Registration Number are shown as data-entry fields, too. (Pg. 21, ln. 11 – Pg. 22, ln. 8) As shown in Figure 16, the user can also save the selected items such that the same items will appear after the user has stopped using the present invention and starts using it again after a period of time. (Pg. 22, ln. 9 – Pg. 23, ln. 5).

To determine which data-entry fields are displayed, the present invention uses flags which correspond in a one-to-one manner with each data-entry field. When a display flag is 1, the corresponding data-entry fields are to be displayed and when the display flag is 0, the

corresponding data-entry fields are to be hidden. (Pg. 16, ln. 25 – Pg. 17, ln. 3) Thus, the classifications category has display flags "1100" while the numbers category has display flags "0100001000" as shown in Figures 14 and 15. (Pg. 17, lns. 5 – 15).

The Office Action rejected Claims 1, 2, 4, 6, 9, and 13-14 under 35 U.S.C. §102(e) as being anticipated by *Subramaniam et al.* (U.S. 6,728,702). The Office Action also rejected Claims 3, 5, 7, 8, 11 under 35 U.S.C. §103(a) as being unpatentable over *Subramanium* in view of *Dasan* (U.S. 5,761,662) and Claim 10 further in view of *Greyvenstein et al.* (U.S. Pub. 2001/0032200).

Subramaniam allows users to search the database and quickly retrieve a record or piece of information. (Col. 2, lns. 60 – 62). As shown in Figure 4, *Subramaniam* uses a search tool bar 400 with a drop down list 405 and an edit button 410. The search toolbar is displayed on the toolbar, tabs & visibility area 505 shown in Figure 5. When the user selects an item from drop down list 405, the content area 510 or the search frame 515 is populated. The drop down list 405 can be edited by pressing the edit button 410. (Col. 8, lns. 14 – 41). As shown in Figures 26 – 29, the basic server applet which is displayed in the search frame 515 displays different search options available to the user. (Col. 21, ln. 15 – Col. 22, ln. 42).

With respect to Claim 1, *Subramanium* does not teach or suggest "a field information holding unit operable to hold, for each of search purposes corresponding to procedures relating to patent, field information as display flags that correspond one-to-one to data-entry fields to be used by the user for entering the search criterion, and that each indicates whether or not to display a corresponding one of the data-entry fields." *Subramanium* only indicates that when the user selects an item from the drop down list 405, the content area 510 or the search frame 515 is

populated. (Col. 8, lns. 14 – 41) *Subramanium* does not teach or suggest using display flags to determine whether a data-entry field should be viewable or hidden to a user.

To determine which data-entry fields are displayed, the present invention uses flags which correspond in a one-to-one manner with each data-entry field. When a display flag is 1, the corresponding data-entry fields are to be displayed and when the display flag is 0, the corresponding data-entry fields are to be hidden. (Pg. 16, ln. 25 – Pg. 17, ln. 3) Thus, the classifications category has display flags "1100" while the numbers category has display flags "0100001000" as shown in Figures 14 and 15. (Pg. 17, lns. 5 – 15). Furthermore, the display flags can be saved, so that when a user returns a while later, he can have the same data-entry fields displayed. (Pg. 22, ln. 9 – Pg. 23, ln. 5)

Subramaniam also does not disclose "an update unit operable to update the field information by setting display flags corresponding to the selected data-entry fields and clearing display flags corresponding to data-entry fields not selected by the user." Since *Subramaniam* does not use display flags, it does not update the field information by setting display flags corresponding to the selected data-entry fields and clearing display flags corresponding to data-entry fields not selected by the user.

Subramaniam also fails to recite "a field display unit operable, in accordance with the field information, to display the data-entry fields for which the display flags have been set, and not display the data-entry fields for which the display flags have been cleared." *Subramaniam* only teaches selecting one of the options, but does not disclose using display flags to wherein the value of the display flag corresponds with whether the data-entry field is viewable or hidden.

Dasan is an automatic method and system for retrieving information based on a user-defined profile such as a personalized newspaper. (Abstract) In *Dasan*, the user selects which

categories or types of information he wants to receive and the server then automatically and periodically sends him the information the user requests to the user. (Col. 2, lns. 1 – 53).

Dasan also does not teach or suggest "a field information holding unit operable to hold, for each of search purposes corresponding to procedures relating to patent, field information as display flags that correspond one-to-one to data-entry fields to be used by the user for entering the search criterion, and that each indicates whether or not to display a corresponding one of the data-entry fields." In *Dasan*, the first application program examines the database of information and automatically retrieves a subset of the information from the database based upon the interests that the user selects. There is no indication that display flags are used to display data-entry fields. The source identifications are not display flags as the first application uses the source identification to search for sources identified by the source identification. The sources are then displayed as opposed to data-entry fields corresponding to the source identifications. The sources are news sources such as raw news source, USENet newsgroup, Reuters, Associated Press, etc. (Col. 2, lns. 34 – 37; Col. 6, lns. 13 - 18). There is no indication that the search results would return old news that has already been delivered to the user in the past.

In contrast, in the present invention, the display flags correspond to data-entry fields and not news sources. Thus, when a display flag corresponding to a data-entry field is selected, the data-entry field appears and allows the user to enter the data-entry field. Furthermore, the data-entry fields correspond to information relating to patents as opposed to news sources. In addition, in the present invention, the search can be initiated by the user, whereas in *Dasan*, "the first application program examines the database of information and automatically retrieves a subset of the information from the database based upon the user-defined profile at periodic intervals." (emphasis added) (Col. 2, lns. 29 – 33). The present invention allows a user to

reconfigure the search engine, whereas in *Dasan*, the user modifies the search terms using the same search engine.

Dasan also does not disclose "an update unit operable to update the field information by setting display flags corresponding to the selected data-entry fields and clearing display flags corresponding to data-entry fields not selected by the user." *Dasan* only retrieves data based on the selected source identifications and does not update the field information. Furthermore, it does not update the field information by setting and clearing display flag.

Dasan also fails to teach or suggest "a field display unit operable, in accordance with the field information, to display the data-entry fields for which the display flags have been set, and not display the data-entry fields for which the display flags have been cleared." Again, *Dasan* does not display or not display data-entry fields based on whether the display flags have been set or cleared.

Greyvenstein enables a patentee to obtain outside input as to the viability of the invention which has been patented. (Abstract) A user fills out a questionnaire and in response a report is generated for the user. (¶ 0024).

Greyvenstein does not teach or suggest "a field information holding unit operable to hold, for each of search purposes corresponding to procedures relating to patent, field information as display flags that correspond one-to-one to data-entry fields to be used by the user for entering the search criterion, and that each indicates whether or not to display a corresponding one of the data-entry fields." There is no suggestion in *Greyvenstein* to use display flags that correspond one-to-one to data entry fields.

Greyvenstein also does not disclose "an update unit operable to update the field information by setting display flags corresponding to the selected data-entry fields and clearing

display flags corresponding to data-entry fields not selected by the user." *Greyvenstein* does not disclose updating the filed information, nor does it disclose using the display flags to update the *Greyvenstein* also fails to teach or suggest "a field display unit operable, in accordance with the field information, to display the data-entry fields for which the display flags have been set, and not display the data-entry fields for which the display flags have been cleared." *Greyvenstein* does not display or not display data-entry fields based on whether the display flags have been set or cleared, especially since *Greyvenstein* does not disclose using display flags.

Furthermore, there is no motivation to combine the invention. A person having ordinary skill in the art to attempting to create an invention to search the database and quickly retrieve a record or piece of information in *Subramaniam* would not look to an invention for retrieving information based on a user-defined profile such as a personalized newspaper in *Dasan* or an invention to obtain outside input as to the viability of the invention which has been patented in *Greyvenstein*. This is especially true considering that *Subramaniam* is directed towards a more efficient method for searching and retrieving records while *Dasan* is delivering news and/or articles based on the subscription of the user. *Subramaniam* may return results that a user has already seen while *Dasan* may return results only new to the user. *Subramaniam* allows a user to enter searches rapidly while *Dasan* delivers content at periodic intervals.

As noted in MPEP 2143.01

> If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Even if the references were combined, however improperly, the hypothetical invention would still not have the features of the present invention. It would not have "a field information

holding unit operable to hold, for each of search purposes corresponding to procedures relating to patent, field information as display flags that correspond one-to-one to data-entry fields to be used by the user for entering the search criterion, and that each indicates whether or not to display a corresponding one of the data-entry fields," "an update unit operable to update the field information by setting display flags corresponding to the selected data-entry fields and clearing display flags corresponding to data-entry fields not selected by the user," or "a field display unit operable, in accordance with the field information, to display the data-entry fields for which the display flags have been set, and not display the data-entry fields for which the display flags have been cleared." There is no teaching in any of the references on the use of display flags that correspond to the data-entry fields.

All arguments for patentability with respect to Claim 1 is repeated and incorporated herein for Claims 13 and 14.

With respect to Claim 16, neither *Subramaniam*, *Dasan*, or *Greyvenstein* teach or suggest "the field receiving unit receives from the user, a selection two or more data-entry fields that are to be used for conducting the search from the data-entry fields displayed in the list, the update unit updates the field information by setting display flags corresponding to the two or more selected data-entry fields and clearing display flags corresponding to data-entry fields not selected by the user, and the field display unit, in accordance with the field information, simultaneously displays the two or more data-entry fields for which the display flags have been set, and not display the data-entry fields for which the display flags have been cleared." As shown in Figure 26, *Subramaniam* only displays one selected data-entry field at once. *Dasan* and *Greyvenstein* do not discuss displaying multiple selected data-entry fields at the same time.

For Claim 17, neither *Subramaniam*, *Dasan*, nor *Greyvenstein* disclose "a user ID input unit to accept a user ID wherein the display flags are associated with the user ID such that the display flags are preserved when the user ID is accepted at a subsequent period of time." None of the references disclose accepting a user ID and associating the user ID with the display flags to preserve the display flags when the user ID is accepted at a later time. In the present invention, the user can save the selected items such that the same items will appear after the user has stopped using the present invention and starts using it again after a period of time. (Pg. 22, ln. 9 – Pg. 23, ln. 5; Fig. 16).

With respect to Claim 18, neither *Subramaniam*, *Dasan*, nor *Greyvenstein* disclose "wherein the display flags have a value of 1 if the display flags have been set, and the display flags have a value of 0 if the display flags have been cleared." None of the three references disclose the display flags having a value of 1 or 0.

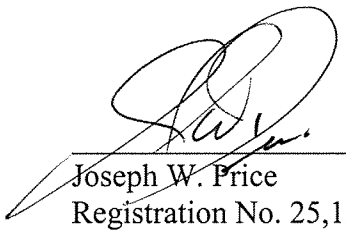
Dependent Claim 5 and 15 – 18 depend from and further limits Claim 1 and are allowable, too.

It is believed the present application is now allowable and an early notice of the same is requested.

If the Examiner believes a telephone interview will help further the prosecution of this case, he is respectfully requested to contact the undersigned attorney at the listed phone number.

Very truly yours,

SNELL & WILMER L.L.P.



Joseph W. Price
Registration No. 25,124
600 Anton Boulevard, Suite 1400
Costa Mesa, California 92626-7689
Telephone: (714) 427-7420
Facsimile: (714) 427-7799